

REMARKS

Summary

Claim 8 was previously cancelled without prejudice.

Additionally, claims 7, 9-11, 21-23, 30, 39-40 and 47 have also been cancelled.

Claims 1, 5-6, 12-14, 16-17, 19-20, 24-29, 31-33, 35-36, 38, 41-46, 48-50, 52-53 and 55 have been amended. New claims 56-61 have been added. All amendments are fully supported by the original disclosure. No new matter has been introduced.

Claims 1-6, 12-20, 24-29, 31-38, 41-46, and 48-63 are now pending.

Rejections of Claims 1, 3, 5-6, 9, 12-14, 20-27, 28-32, 39-41, and 43-49

Claims 1, 3, 5-6, 9, 12-14, 20-27, 28-32, 39-41, and 43-49 have been rejected under 35 U.S.C. 103(a) as being unpatentable over United States Patent 6,874,023 to Pennell, *et al.* ("Pennell"), in view of Applicant Admitted Prior Art (AAPA). Applicant respectfully traverses.

Rejections of claims 9, 21-23, 30, 39-40 and 47 have been rendered moot by their cancellations.

In rejecting claim 1, the Examiner asserted that in page 1, lines 21-26 of Applicant's specification, Applicant has admitted the prior art as having taught request of an email address from an email service provider by a subscriber after enrollment with the email service provider for email service. Therefore, Pennell's deficiency in teachings is remedied, rendering claim 1 obvious.

In the subject portion of Applicant's specification, it merely states

Currently, under the prior art, a more sophisticated user may have as many as a handful of email addresses, a work related email address hosted by the IT establishment of the user's employer, a personal email address hosted by the user's Internet access provider (as part of the "access service"), and one or more personal email addresses hosted by the free email services, such as Hotmail.com, Yahoo mail, and the like (to attract the user to visit the site).

Applicant submits nowhere in the subject passage did Applicant admit the prior art as having taught or suggested the relevant recitation of claim 1 of “the first and second email addresses were simultaneously provided to the user computer by the email service provider in advance of the first and second email addresses’ initial selection for usage by the user computer.”

Thus, the subject portion of Applicant’s specification does not remedy Pennell’s deficiency in teaching.

Therefore, for at least the forgoing reason, Applicant submits claim 1 is patentable over Pennell, in view of page 1, lines 21-26 of Applicant’s specification.

The Examiner further rejected claims 24, 28, 41 and 45 as being unpatentable over Pennell in view of “AAPA”. Claims 28 and 45 have been amended to recite in substance the same requirements as claim 1. Accordingly, for at least the same reasons, claims 28 and 45 are patentable over Pennell.

Claims 24 and 41 have been amended to recite “each of the first and second email address is provided to the user computer by the email service provider in real time respectively at the first and second email addresses’ respective initial selection for usage, in response to a first and a second request … after enrollment of the user as a service subscriber of the email service provider”.

Applicant submits nowhere in the subject passage did Applicant admit the prior art as having taught or suggested the substance of this recitation. Thus, the subject portion of Applicant’s specification does not remedy Pennell’s deficiency in teaching. Accordingly, claims 24 and 41 are patentable over Pennell and “AAPA” combined.

Claims 3, 5-6, 12-14, 20, 25-27, 29, 31-32, 43, 44, 46, and 48-49 are dependent on claims 1, 24, 28, 41 and 45 incorporating their recitations respectively. Therefore, for at least the same reasons, claims 3, 5-6, 12-14, 20, 25-27, 29, 31-32, 43, 44, 46, and 48-49 are patentable over Pennell and “AAPA” combined.

Rejections of Claims 2, 4, 7, 10, and 11

Claims 2, 4, 7, 10, and 11 have been rejected under 35 U.S.C. 103(a) as being unpatentable over Pennell, in view of Applicant Admitted Prior Art (AAPA), in further view of Linden, *et al.* Applicant respectfully traverses.

Rejections against claims 7, 10 and 11 have been rendered moot by their cancellations.

Linden does not remedy the above discussed deficiencies of Pennell and "AAPA". Therefore, claim 1 remains patentable over Pennell, "AAPA" and Linden combined together. Both claims 2 and 4 depend from claim 1 incorporating its recitations. Therefore, for at least the same reasons, claims 2 and 4 are patentable over Pennell, "AAPA", and Linden combined.

Rejections of Claim 15

Claim 15 has been rejected under 35 U.S.C. 103(a) as being unpatentable over Pennell, in view of Applicant Admitted Prior Art (AAPA), in further view of Kamiya, *et al.* Applicant respectfully traverses.

Kamiya does not cure the deficiencies of Pennell and "AAPA". Accordingly, claim 1 remains patentable over Pennell, "AAPA" and Kamiya combined. Claim 15 depends from claim 1 incorporating its recitations. Therefore, for at least the same reason, claim 15 is patentable over Pennell, "AAPA" and Kamiya combined.

Rejections of claims 16-19

Claims 16-19 have been rejected under 35 U.S.C. 103(a) as being unpatentable over Pennell, in view of Applicant Admitted Prior Art (AAPA), Kamiya, and in further view of Flemming, III, *et al.* Applicant respectfully traverses.

Flemming, III fails to cure the deficiencies of Pennell, "AAPA" and Kamiya. Accordingly claim 1 remains patentable over Pennell, "AAPA", Kamiya and Flemming, III combined. Claims 16-19 depend from claim 1 incorporating its recitations. Therefore, for at least the same reason, claims 16-19 are patentable over Pennell, "AAPA", Kamiya and Flemming, III combined.

Rejections of claims 33-38, and 50-55

Claims 33-38, and 50-55 have been rejected under 35 U.S.C. 103(a) as being unpatentable over Pennell, in view of Kamiya and in further view of Flemming, III, et al. Applicant respectfully traverses.

Pennell, Kamiya and Flemming in combination do not teach or suggest the recited organization of emails of claims 33, 35, 50 and 52 where the organization involves organizing emails addressed to different email addresses of a user, where the different email addresses are provided by the same email service provider.

Accordingly, claims 33, 35, 50 and 52 are patentable over Pennell, Kamiya and Flemming combined.

Claims 34, 36-38, 51 and 53-55 depend from claims 33, 35, 50 and 52 incorporating their recitations respectively. Accordingly, for at least the same reasons, claims 34, 36-38, 51 and 53-55 are patentable over Pennell, Kamiya and Flemming combined.

New claims 56-61

Claims 56 and 59 contain substantially the same recitations of claim 45 and 41, respectively. Further, claims 57-58 and 60-61 depend from claims 56 and 59, respectively. Therefore, for at least the same reasons discussed earlier for claims 41-46, claims 56-61 are patentable over the cited references.

Conclusion

In view of the foregoing, Applicant respectfully submits that claims 1-6, 12-20, 24-29, 31-38, 41-46 and 48-61 are in condition for allowance, and early issuance of the Notice of Allowance is respectfully requested.

Please charge any shortages and credit any overages of Fees to Deposit
Account No. 500393.

Respectfully submitted,
Schwabe, Williamson & Wyatt, PC

Date: August 8, 2005


Al AuYeung
Reg. No. 35,432

Schwabe, Williamson & Wyatt, P.C.
Pacwest Center, Stes. 1600-1900
1211 SW Fifth Avenue
Portland, OR 97204-3795
Telephone 503 222 9981